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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,965	09/05/2003	Gunnar Back	3191/11393US1	1670
7278	7590	10/15/2004	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			BONCK, RODNEY H	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/656,965	Applicant(s) BACK ET AL. 	
	Examiner Rodney H. Bonck	Art Unit 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/842,362.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/11/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a first action on the merits of application Serial No.10/656,965, filed September 5, 2003.

Priority

If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. ____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35

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U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Information Disclosure Statement

Receipt is acknowledged of the Information Disclosure Statement filed May 11, 2004. The cited documents have been considered.

Claim Objections

Claims 1 and 9 are objected to because of the following informalities:

In lines 8-10 of claim 1, "and arranged to transmit variable torque between said housing" is repeated. In lines 20-21 of claim 1, "and frictionally engaging the other of said components" is repeated. In line 24 of claim 1, "radially" apparently should be – radially --. In line 2 of claim 9, "min." apparently should be – mm. --

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It appears that claim 2 does not further limit claim 1 in reciting that "said recesses are provided in surface of at least one of said components." Claim 1 already recites that the recesses "are provided in at least one of said surfaces" (see line 25).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by either Back et al.(US 2002/0027053 A1) or Back et al.(JP 2001-355704). These prior

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publications of applicants' invention constitute prior art until such time as applicants satisfy the requirements for priority under 35 USC 120.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Fallu('896). The Fallu device discloses a housing 14, a pump 22, a turbine 28, means for rotating the housing (not shown), an output element 42, and a fluid-operated bypass clutch having a driving component 65 and a driven component 66. First and second plenum chambers provide a means for moving the driven component. Fluid flow between the chambers is regulated according to the amount of torque transmitted (see column 3, line 58, to column 4, line 3). The clutch further includes a friction lining 61 having radial recesses 92. The recesses are formed by embossments 80.

Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Dehrmann et al.('043). The Dehrmann et al. device discloses a housing 13, a pump 6, a turbine 7, means for rotating the housing (not shown), an output element 15, and a fluid-operated bypass clutch 16 having a driving component 13 and a driven component 44. First and second plenum chambers provide a means for moving the driven component. Fluid flow between the chambers is regulated according to the amount of torque transmitted (see column 7, line 22, to column 8, line 32). The clutch further includes a friction surfaces having radial recesses 62 and a friction lining 61, which can be considered a washer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Fallu('896) or Dehrmann et al.('043). While neither Fallu nor Dehrmann et al. disclose the specific number of recesses or dimensions of the recesses claimed here, it is submitted that it would have been within the purview of the artisan to arrive at an appropriate number of recesses and an appropriate recess configuration to provide a desired fluid flow. Thus claiming, for example, that there are between 10 and 400 recesses, or that the recesses are between 10 and 50 mm, or that the recesses are less

than .3mm deep is not seen to patentably distinguish over the Fallu and Dehrmann et al. devices.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Fallu('896) or Dehrmann et al.('043) in view of Otto et al.('327). In Fallu and Dehrmann et al. it is not clear whether the recesses are embossed into the surface and/or defined by displaced material. This technique for forming recesses is known in this art as taught by Otto et al. (see column 6, lines 10-12). It would have been obvious to emboss or displace material to form the recesses in the friction surface of either Fallu or Dehrmann et al., the motivation being to use a technique known to provide suitable recesses in this environment.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Fallu('896) or Dehrmann et al.('043) in view of Schoder('621). It is not clear from Fallu or Dehrmann et al. whether the edges of the recesses are rounded. Schoder teaches providing a rounded edge at 42 (Fig. 3) to reduce abrasion between the friction surface and the counter friction surface. It would have been obvious to provide rounded edges at the recesses in Fallu and Dehrmann et al., the motivation being to reduce abrasion between the friction surface and the counter friction surface.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanaka('8350 and Walth et al.('366) are cited for their teaching concerning recess configurations, such as depth.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (703)-308-2904. The examiner can normally be reached on Monday-Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (703)-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rodney H. Bonck
Primary Examiner
Art Unit 3681

rhb
October 12, 2004